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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,566	06/30/2003	Kazuhito Okumura	Q76084	7294

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EXAMINER

SOUW, BERNARD E

ART UNIT PAPER NUMBER

2881

DATE MAILED: 03/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/608,566

Applicant(s)

OKUMURA, KAZUHIITO

Examiner

Bernard E Souw

Art Unit

2881

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 30 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>06/30/2003</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2 and 7-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Shinoda et al. (USPAT 5,489,474), hereinafter denoted as Shinoda'474.

► Regarding claim 1, 7 and 9, Shinoda'474 discloses a surface protection film, as recited in Col.3/ll.5-6 + ll.45-47, which comprises a base material film comprising a polylactic acid (or lactic acid) based film, as recited in Col.3/ll.5-17 + 23-29, also in Col.1/ll.12-20 + 25-40.

The recitation of "*for optical films*" in the preamble of claim 1 is *not given patentable weight* because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a *structure* and the portion of the claim following the preamble is a self-contained description of the structure not depending for

completeness upon the introductory clause. *In re Kropa v. Robie*, 88 USPQ 478 (CCPA 1951).

The same argument applies to claims 7 and 9: The method of “*protecting a surface of an optical film*” in claim 7, and “*protecting a surface of an image display device*” in claim 9 are not given more patentable weight beyond “*protecting a surface*”.

Furthermore, Shinoda’s surface protection film is used for protecting general surfaces, including display devices, as recited in Col.3/ll.5-6, whereby a watch as recited in line 50, as well as woodboards and decorative laminates recited in line 49, are conventionally understood in the art as “*image display device*”.

► Regarding claim 2, 8 and 10, Shinoda’s surface protection film also comprises a pressure-sensitive adhesive layer disposed on one side of the base material film, as recited in Col.3/ll.13-16 + 18-19 + 23-29 and also in Col.1/ll.21-22.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 2 and 7-10 are also rejected under 35 U.S.C. 103(a) as being unpatentable over Okumura et al. (USPAT 6,407,788, hereinafter denoted by Okumura’788) in view of Shinoda’474, and further in view of Kobayashi et al.,

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"Structural and optical properties of poly lactic acids", J. Appl. Phys. 77(7), 1995, Faerch Plast at <http://www.faerchplast.com/pla.asp>., "PLA (Poly Lactic Acid)", and Dow and Cargill, article dated August 04, 2000, available at <http://retailindustry.about.com/gi/dynamic/offsite.htm?site=http%3A%2F%2Fwww.socialfunds.com%2Fnews%2Farticle.cgi%3FsfArticleId%3D328>

Okumura'788 discloses an "*optical film*" 1 shown in Fig.1 (the only figure drawing in the document), i.e., specifically a liquid crystal film that is known in the art as being simultaneously also an "*image display device*", having its surface protected by a surface protection film 2. However, Okumura's surface protection film is not made of polylactic acid.

Shinoda'474 show all the limitations of claims 1, 2 and 7-10, as applied to the same claims under §102(b) above. Specifically, Shinoda's surface protection film is used for protecting general types of surfaces, including display devices, as recited in Col.3/ll.5-6, whereby a watch as recited in line 50 as well as woodboards and decorative laminates recited in line 49 are conventionally understood in the art as "*image display device*".

Although Shinoda'474 does not expressly recite the word "*optical surface*" and "*image display device*" as specific types of surface on which the polylactic acid (or lactic acid) based film is applied as protection, these surface types are inherent in Shinoda's general definition of surface, and is already recited by Okumura'788, as described previously.

Although Okumura's surface protection film is not made of polylactic acid, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use Shinoda's polylactic acid based film in place of Okumura's surface protection film, since polylactic acid based film is known in the art as being transparent and mechanically tough, hence scratch-resistant.

Evidence for the optical transparency of polylactic acid based film is given by Kobayashi et al., as inherently implicated by the entire discussion regarding optical properties of polylactic acid. The word "*transparent*" is expressly recited in a website publication by the company Faerch Plast, as recited on page 1, line 7.

Evidence for a mechanical toughness of polylactic acid based surface protection films is demonstrated by the fact that it has been used as surface protection on floor-covering tiles produced by Dow and Cargill, as recited in a website article dated at least since August 04, 2000.

4. Claims 3-6 are also rejected under 35 U.S.C. 103(a) as being unpatentable over Okumura'788 in view of Shinoda'474, Kobayashi et al., Faerch Plast and Dow et al..

Okumura'788 as modified by Shinoda'474, Kobayashi et al., Faerch Plast and Dow et al. show all the limitations of claims 3-6, as applied to claims 1 and 2 above, except for specifying an optical film and an image display device having their surface protected by a surface protection film as claimed in claims 1 and 2, respectively.

Claims 3 and 4 claim for an "*optical film*" having its surface protected by a surface protection film as claimed in claims 1 and 2, respectively. Claims 5 and 6 claim

for an "*image display device*" having its surface also protected by a surface protection film as claimed in claims 1 and 2, respectively. Thus, claims 3-6 are related as "Product by Process" to method claims 7-10. As such, claims 3-6 are rejected by the same reason over the same prior art as claims 7-10.


Communications

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bernard E Souw whose telephone number is 571 272 2482. The examiner can normally be reached on Monday thru Friday, 9:00 am to 5:00 pm..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John R Lee can be reached on 571 272 2477. The central fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306 for regular communications as well as for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 0956.

bes
March 5, 2004


JOHN R. LEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800